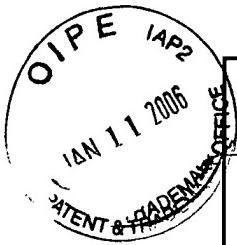


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 03485/100H799-US1	
	Application Number 10/001,772-Conf. #4306	Filed October 31, 2001	
	First Named Inventor Anand Subramanian et al.		
	Art Unit 3622	Examiner R. Alvarez	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant /inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)

attorney or agent of record.

Registration number 47,698


Signature

Richard J. Katz
Typed or printed name

(212) 527-7700

Telephone number

January 11, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Anand SUBRAMANIAN, et al.

Application No.: 10/001,772

Art Unit: 3622

Filed: October 31, 2001

Examiner: Raquel Alvarez

For: INTERNET CONTEXTUAL COMMUNICATION
SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Concurrent with the filing of a Notice of Appeal, and in accordance with the Pre-Appeal Brief Conference Pilot Program, Applicants hereby request a pre-Appeal Brief review of the final rejection mailed July 13, 2005 in the above-identified application. No amendments are being filed with this request. With all claims having been twice rejected, an appeal is proper in accordance with 37 C.F.R. § 41.31(a).

Claims 15, 16, 21, 22 and 27-89 are pending in the application. The sole question on appeal is whether the Examiner is correct in rejecting claims 15, 16, 21, 22, 27-31, 33-35, 37-89 as being anticipated by U.S. Patent No. 5,835,087 to Herz et al. ("Herz"), and rejecting claims 32 and 36 as being unpatentable over Herz in view of the Examiner's statement of what was known in the art at the time of the invention. *See* July 13, 2005 Final Office Action, item 3, page 2, and item 4, page 3.

In the present application, the claimed invention is directed to systems and methods for delivering advertisements to "a user viewing content by operating a station connected to a distributed computer network." *See* claim 15, preamble. Independent claim 15 recites that "the station allow[s] the user to retrieve information containing content," and there is "a data store containing a set of relevancy rules associated with each ad, the rules operable to indicate a level of relevancy of the ad to the content of the information retrieved [by the user]." *See* claim 15 (emphasis added), Amendment After Final Action, mailed December 13, 2005; entered by the Advisory Action, mailed January 9, 2006. Claim 15 further

recites that a matchmaker “parses the content of the information [retrieved by the user] into objects,” and “targets an ad from the server to the content by applying the relevancy rules in the data store to the objects, free of information about the user.” The invention then “sends the targeted ad to the station for display with the content.” Thus, the claimed invention determines the relevancy of an advertisement in relation to information retrieved by the user (“free of information about the user”), and displays the advertisement and the content of the retrieved information at the station. Independent claims 21 and 89 recite similar subject matter.

A. Herz Fails to Disclose Applying Relevancy Rules to Extracted Objects in the Content of the Information Retrieved by a User So As to Target an Advertisement to the User

Herz discloses a system that automatically constructs both a “target profile” for each target object (e.g., a news article, an advertisement, or a coupon) in an electronic media environment, and a “target profile interest summary” for each user. The system then evaluates the target profiles against the user’s target profile interest summaries to determine whether a listing of the article or ad is to be sent to the user. *See Herz, Abstract.* This system operates as a “push” system, meaning that based on a user’s prior interests, Herz pushes a list of news articles or advertisements to the user, which are available for potential viewing by the user. The list is not sent together with any content the user has actively sought. The present invention could be styled a “pull and drag” system — *i.e.*, the user goes on the Internet seeking content which is pulled to his work station. The act of pulling certain content implements the claimed invention with the effect of dragging an advertisement, which is relevant to the pulled content, to the work station for display with the content. *See Amendment After Final Action*, pages 22-23.

The Examiner contends that Herz discloses “that the target profile for the electronic media is based solely on the frequency with [which] the words appear in an article (col. 6, lines 34-46),” and that “[the] first module targets the ads solely on the frequency of the words that appear on the article.” *See Final Office Action*, item 3, page 3; and item 6, page 5. In the Advisory Action, the Examiner further contends that: “In Herz, a profile for the article is generated and is filtered based on the occurrence/frequency of particular words in the article in order to customize ‘electronic identification of additional objects’ (col. 55, lines 45-67).”

While the Examiner has described Herz’s first module, which generates the “target profile for the electronic media” (e.g., a profile of an advertisement), the Examiner has failed to appreciate that before an advertisement is targeted by Herz’s system, the user’s profile is determined and the target profile is compared to the user profile. In particular, “a profile processing module which estimates each user’s interest in various target objects by reference to the users’ target profile interest summaries, for example by comparing the target profiles of these target objects against the search profiles in users’ search profile

sets, and generates for each user a customized rank-ordered listing of target objects most likely to be of interest to that user.” *See Herz, column 6, lines 42-58 (emphasis added).*

Thus, the Examiner is incorrect in stating that Herz’s “first module targets ads solely on the frequency of the words that appear on the article.” Rather than discerning that Herz requires comparing the ad profile with a user profile in order to perform the targeting operation, the Examiner argues that:

Herz does take the customization a little bit further by additionally further matching the additional objects to a user search profile. Nevertheless, Herz first generated target profile is based on the words contained in the article (col. 55, lines 50-54). The ads or additional content that is going to be presented to the users is based on words frequency presented in the article viewed by the user.

The difficulty with the Examiner’s argument is that the claims recite “target[ing] an ad from the server to the content by applying the relevancy rules in the data store to the objects [parsed from the retrieved information], free of information about the user.” Herz determines the occurrence of words in the ad, but fails to suggest targeting the ad based on the retrieved information, as opposed to information about the user. Herz discloses that the user’s “target profile interest summaries” correspond to topics of interest for the user. “[N]ew articles whose [article] target profiles are closest (most similar) to the closest search profile in a user’s search profile set are identified to that user for possible reading.” Herz, column 55, lines 64-67. The present claims specifically recite that the relevancy rules are applied to the objects parsed from the content of the information retrieved by the user, and that the relevancy rules are applied “free of information about the user.”

Accordingly, Applicants submit that Herz discloses determining the relevancy of an advertisement based on its own content in comparison to a user’s profile and sending a list of relevant ads to the user for possible reading. In contrast, the claimed invention determines the relevancy of an advertisement based on “a set of relevancy rules associated with each ad” (where the relevancy rules may or may not depend on the content of the ad) compared to objects extracted from “the content of the information retrieved” (“free of information about the user”) and “sends the targeted ad to the station for display with the content.”

B. Herz Fails to Disclose Directly Sending the Targeted Ad For Display With the Retrieved Content

In the January 9, 2006 Advisory Action the Examiner attempts to show Herz does display the ad with the retrieved content. The Examiner states:

Herz teaches on Figure 10 that based on the news access [sic] by the user, the list of news and ads is presented to the users (1104). The ads presented to the users is [sic] based on

the information requested by the users and the profile of the article (Col. 56, lines 53 to col. 57, lines 1-10).

Applicant argues that Herz doesn't teach displaying the targeted ads at the station with the content. The Examiner disagrees with Applicant because in step 1103 based on the news accessed by the user and the profile of the article, **a list is presented to the users**, step 1105. (Emphasis added.)

The Examiner's own analysis states that "a list is presented to the users." Herz clearly discloses "generat[ing] for each user a customized **rank-ordered listing** of target objects most likely to be of interest to that user." Herz, column 6, lines 56-58 (emphasis added). However, the claimed invention "directly sends the targeted ad to the station for display with the content."

Further with respect to Fig. 10, Herz discloses that "[w]hen the user requests access to 'news' at step 1102, the profile matching module 203 resident on proxy server S₂ sequentially considers each search profile P_k from the user's search profile set to determine which news articles are most likely of interest to the user." Herz, column 57, lines 23-27. This process is recursively executed until articles of interest to the user are identified. Here again, Herz discloses identifying an ad by considering a user's search profile. At step 1104 a list of the identified articles is stored and at a user's request for "news" in general, the list is presented to him. Herz, column 58, lines 27-34 (step 1103 is not identified in the written description). In contrast to "displaying the targeted ads at the station with the content," as recited in the claims, Herz discloses merely presenting a rank-ordered list of possible items for viewing to the user, where the possible items are selected by considering the user's search profile.

In the above-quoted section of the Advisory Action, the Examiner states that the "ads presented to the users [are] based on the information requested by the users," and that step 1103 shows that the list of articles sent to the user is "based on the news accessed by the user." The Examiner's analysis implies that the list of articles is based on the current information retrieved by the user. However, such is not the case and such an operation is not supported by Herz at column 56, lines 53 to column 57 line 10. As described in column 57, lines 11-39, the user logs onto the system and requests suggestions of available content that may be of interest; but, the user does not request any specific content. In response, Herz's system sends the list to the user for consideration. Thus, the user has not retrieved any content, so the list sent to the user is not viewed with content. Further, one cannot read Herz as disclosing that a targeted ad is displayed with the content. Each item in the list is separately selected for viewing by itself.

For the reasons demonstrated above, Applicants submit that Herz does not disclose each and every feature of the claimed invention. Therefore, Herz does not anticipate independent claims 15, 21 and 89, nor their respective base claims.

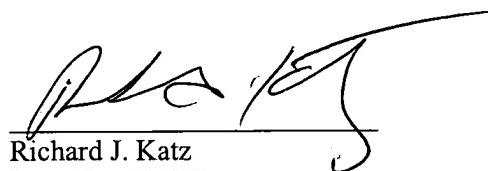
C. The Examiner Fails to Establish a *Prima Facie* Case of Obviousness

Claims 32 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herz in view of the Examiner's statement of what was known in the art at the time of the invention. The Examiner contends that the subject matter of dependent claims 32 and 36 are "old and well known in the computer related arts." However, the Examiner's Statement does not provide those features of claims 32 and 36 demonstrated above to be missing from Herz with respect to independent claims 15, 21 and 89. Thus, the combination of Herz and the Examiner's Statement does not result in the invention of claims 32 and 36. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness with respect to claims 32 and 36.

Conclusion

For the reasons demonstrated above, Applicants believe that claims 15, 16, 21, 22 and 27-89 are patentable over Herz and the combination of Herz and the Examiner's Statement.

Respectfully submitted,



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Dated: January 11, 2006

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